

Applicant: Flickinger et al.

Serial No. 09/740,051

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Remarks

Applicant notes that prosecution of this application is in its 6th year, and respectfully requests that prosecution be concluded as soon as possible. Applicant believes application is in condition for allowance. Examiner's summary of the telephonic interview of 7/19/2005 is accurate, and applicant notes the withdrawal of the finality of the prior action. Claims 1-24 are pending and claims 1-24 have been rejected. The following remarks are respectfully submitted.

Applicant submits herewith Rule 131 declarations (37 CFR 1.131) from the inventors of the present application, said declarations, in compliance with 37 CFR 1.131, show the facts that the subject matter described and claimed in the present application were conceived prior to the effective date of the cited Suliman reference coupled with due diligence on the part of the applicants from the effective date of the reference, 12-16-1999, to the filing of provisional patent application Serial No. 60/172397 on December 17, 1999. The Suliman reference is thus removed as properly citable and relied on prior art. All pending rejections being based on the Suliman have thus been overcome and the withdrawal of all rejections and notice of allowance is requested.

Notwithstanding the Rule 131 declaration and noting that Suliman is not prior art to applicant's invention, applicant's remarks below address the substantive issues raised by the rejections. Although the Suliman is not prior art and the reference has been removed as citable prior art as stated above, the following remarks, traversing the substance of the rejections, assume arguendo that Suliman is still properly citable as prior art. Applicant believes that the claims are patentable even if Suliman is prior art, which it is not. None of the remarks that follow should be construed to indicate that applicant accepts the Suliman reference as prior art, which applicant does not.

The Suliman publication and the Suliman provisional application

Paragraph 37 [037] is not fully enabled by the provisional. Figs. 1 and 2, to which [037] refer and describe do not exist in the provisional and cannot be relied upon. To the extent that 037 is supported by the provisional, such support is limited to the extent that it contains the disclosure of the provisional referenced (paragraphs on page 2 – page 3).

Paragraph [045] is not supported by the provisional in any way, directly or indirectly.

Paragraph [052] is not supported in reference to the Figs 1-9, and is not supported with regard to “then as products are purchased associates in the database...”, and is only supported to the extent of the disclosure in the provisional.

Paragraph [062] is not supported in any way, directly or indirectly. Applicant does not understand examiner’s statement and asks for clarification as to its relevance.

Paragraph [066] is not fully supported by the provisional. Figs. 2 and 3, to which [066] refer and describe do not exist in the provisional and cannot be relied upon. 066 is enabled by the provisional to the extent that it contains the disclosure of the provisional referenced (page 3 last para – page 4 first para).

Paragraph [077] is not supported by the provisional in any way, directly or indirectly.

Rejections under 35 USC 103

Claims 1, 3-18, 21-23 have been rejected under 35 USC 103 as being allegedly unpatentable over Suliman in view of Cheng et al (U.S. 6457076). Claims 2, 19, 20, and 24 are rejected under 103(a) as being allegedly unpatentable over Suliman in view of Cheng and further in view of Rogers (U.S. 5978774).

There is insufficient motivation to combine either Cheng or Rogers with Suliman or Rogers with Suliman and Cheng. A prima facie case of obviousness with respect to the pending claims has not been established.

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The following general points apply to each of the individual points discussed below. It is hoped that the pertinence of the arguments presented below will be clearer in light of the following general points.

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under 35 U.S.C.S. § 103, teachings of references can be combined only if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.15, 23 USPQ2d 1780, 1783-84 n.15 (Fed. Cir. 1992),

"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Ibid*

"...obviousness determination generally include the following tenets of patent law that must be adhered to when applying 35 U.S.C.S. § 103: (1) the claimed invention must be considered as a whole; (2) the references must be considered as a whole and suggest the desirability and thus the obviousness of making the combination; (3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention; (4) "ought to be tried" is not the standard with which obviousness is determined; *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986)

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant requests examiner to consider the invention as a whole. It appears that the examiner has included multiple references attempting to show individual elements applicant's invention in order to piece together applicant's invention using applicant's own claims as a guide. No real suggestion or motivation to combine the references has been provided other than generic reasons including simplification and automation, efficiency, speed, and common knowledge. The real issue is whether it would have been obvious at the time of the invention to one of ordinary skill in the art to arrive at the invention by combining the cited references without having applicant's present application and claims as a guide. Applicant submits that it would not because there is no teaching or suggestion to do so and arrive at applicant's invention.

Cheng requires a client module be installed on a users computer and that the user manually enters personal data and that the user logs on each time in order to check for software updates. The motivation for combining Cheng and Suliman, because it would automate and simplify the system, is not sufficient. Suliman (para 8) does not provide said motivation as asserted. Neither automation nor simplification are mentioned in any context in the Suliman priority document. Furthermore, the Suliman invention is directed to maintaining the privacy of the consumers while allowing the manufacturers to track the goods sold (page 2 para 2 of priority document). Applicant disagrees with the blanket assertion that, "*automation and simplification are well within the general knowledge of one possessing ordinary skill*", and request evidence be presented to substantiate the assertion. There is no teaching or suggestion of why or how specifically Cheng should be or could be combined with Suliman to produce applicant's invention. Applicant's invention cannot be relied on for supplying the motivation.

Examiner asserts that the limitation of "extracting data specific to an entity from the electronic file and entering it into a registration database" is old and well know citing the example of a "cookie", and further states that a cookie can contain information such as user id, postal address, etc., and has cited US 20030158889 (Massarani). Applicant requests evidence be provided that at the time of the invention of the applicant, cookies were known to contain all of the information as asserted. While Massarani teaches about cookies and

how they can contain some generic personal data such as gender and state of residence, for the purpose of “profiling” and the like, the disclosure has nothing to do with asset registration, the purposes of the cookies rather being to provide a customized experience to users when they visit a website. The following extract from Massarani is pertinent:

[0046] This invention's primary application is for Web-server sites that want to positively identify the user (not just the client machine or browser with a persistent cookie) on every access session. These sites/applications will always challenge the user for identification and possibly also for password. They then will create and serve a cookie that is valid for that browser session only, not saved in permanent storage (such as a PC hard disk file), and valid for a finite amount of time (slightly greater than typical maximum user session time).

The cookie concept described is not analogous to applicant claimed invention involving the extraction of personal data from an electronic data file and entering it into an asset registration database to register an asset. Moreover, Cheng does not teach data extraction but rather that data can be uploaded by the client module on the user client, thus Cheng is not evidence of such extraction.

Applicant has adequately challenged examiner's application of the cookie concept in rejecting the claims (see prior response). Even assuming arguendo, that applicant did not adequately traverse the assertion, then only the prior art cited is considered admitted, not the claim limitation.

Examiner observes that it would have been obvious to combine Suliman with an extraction technology to arrive at the present invention, the motivation being to “*increase the speed with which the system operates*”, and further notes that “*speeding up speed ...in computing systems is clearly knowledge to one of ordinary skill., and further that Suliman expressly remarks that simplification and automation are goals of the systems.* Applicant disagrees. Suliman does not teach or suggest simplification and automation are goals of the system as mentioned earlier. The motivation is insufficient. There is no teaching or suggestion of why or how specifically a cookie should be or could be combined with Suliman to produce applicant's invention. Conclusory statements of generalized advantages and convenient assumptions are inadequate to support a finding of motivation (In re Beasley, Civ. App. 04-1225 WL 2793170 (Fed Cir 2004))

The references Suliman publication (para 81 and para 37) are not duplicated in the provisional and do not describe a registration process for the entity.

The claim limitation of the registration being performed during the purchase of the asset is not taught, described, or suggested by the Suliman priority document. Specifically, para 12 which examiner references is not supported by the priority document. The portion of the priority document reference describes the situation of registration by the purchaser after the purchase, i.e., after the purchase is completed at a store for example, the purchaser later uses their pc at home to submit product information.

Rogers describes a sales clerk manually scanning a product id code. Thereafter if and when a product is presented to the store for return, the details regarding when the product was purchased can be obtained from the database to determine whether or not the product is authentic and/or is still able to be returned under governing return policies. The application of Rogers is not analogous to that of the present invention. There is no purchaser data whatsoever associated with the registration disclosed by Rogers. Rogers does not teach the limitation of registering the asset for the entity at the time of purchase. In order to establish a prima facie showing of obviousness each limitation must be present in the prior art.

It would not have been obvious to combine Suliman, Cheng, and Rogers to arrive at the claimed invention. The motivation being to "*simply increase confidence in the system by eliminating possible errors that could occur from registering later ...*" is inadequate. There is no teaching or suggestion of why or how specifically Rogers should be or could be combined with Suliman and Cheng to arrive at applicant's invention. Furthermore, there is no purchaser data associated with Rogers. The motivation supplied is derived from hindsight applicant believes.

With regards to the rejections of claims 3, 13, 4, 5, and 14, the remarks above have already addressed and traversed these rejections

Examiner continues dissecting the claim elements piecemeal, rejecting claims 6 and 15 which incorporate the limitation that the third party is a credit card company, on the basis that because credit card companies engage in profiling users, for the purpose of targeted advertising for instance, this demonstrates an "interest", indeed a "*compelling interest in*

product registration". Neither Herz nor the prior art suggest any such a compelling interest in product registration. The importance to credit card companies in monitoring the spending patterns of customers (e.g., for profiling and targeted advertising) and for monitoring card backed reimbursement are suggested as motivations to combine, such knowledge being generally available to one of ordinary skill in the art according the examiner. Applicant disagrees and requests examiner provide evidence to substantiate that assertion. In any case, assuming *arguendo* that knowledge of an ordinary skilled artisan includes that credit card companies have an interest in profiling users and in monitoring warranty issues, such knowledge by itself does not render the invention obvious. Examiner is applying motivation and knowledge gleaned from hindsight. Furthermore, the registration of assets by the credit card company is a new and different business model, a new service offering with significant benefits to consumer for instance (asset management) and also the manufacturer. The prior art provides no suggestion of such a business model or such an involvement of credit card companies in asset registration.

Official Notice is taken that smart cards for storing personal information of the type disclosed by applicant is very old and well known... and that smart-card technology is well established. Applicant traverses and requests examiners to provide evidence substantiating those assertions. The limitation is stated to be obvious in light of the official notice, the motivation to combine examiner's official notice with the Suliman/Cheng/Rogers/Herz combination being to *diminish processing speed in that retrieving stored information is faster than giving it at the POS, and that this knowledge is generally available to one of ordinary skill in the art*. The motivation given is insufficient. Again, even if knowledge that retrieving stored information from a card for instance may be faster than extracting it manually (e.g., by asking for it and typing it in) is known, does not render the invention obvious. The examiner is taking the claim limitation out of context and not looking at the invention as a whole.

Suliman does not teach a registration database that provides a composite record of the assets registered by specific entities and for the reporting and manipulation of the same. Suliman does not teach a registration database where entities maintain control over person

and or other entity registration data in the sense that an entity can update or delete a record or have other control over their registration records in the database.

wherein said asset specific data is not manually provided by the entity and the entering of said data does not depend on the entity directly providing said asset specific data

Rogers is suggested as teaching this limitation, and the invention is deemed an allegedly obvious combination of the teaching of Suliman, relating to a registration database, and of Cheng, relating to a customer information file, and finally Rogers POS product data extraction. The examiner suggests that an increase in confidence by eliminating errors that could occur from registering later, is motivation to combine, and such a motivation is knowledge available to one of ordinary skill in the art at the time of applicant's invention. Applicant disagrees and requests examiner supply evidence to substantiate his assertions. The motivation is insufficient. The motivation to perform asset registration without manual input of asset data by the entity is suggested only by applicant's disclosure.

wherein said data specific to an entity is extracted at the time of purchase of the asset.

The Suliman priority document does not teach the limitation that data specific to the entity is extracted at the time of purchase. It is clear from that portion of the Suliman document referenced (p3 2nd para) describes the circumstance in which after a product is purchased, the purchaser will later, from his home computer, transmit product information to a server. Thus Suliman does not teach the above limitation. Suliman does not teach that a data file with entity information is stored locally at the purchaser computer and to which entity has entered data and may modify data.

Applicant traverses the rejection of claim 24 and notes that rationale used to reject claim 21 has already been challenged and overcome above.

It is respectfully suggested that for all of these reasons, that the current rejections are totally overcome, and that none of the relevant cited art teaches or suggests the features

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which are now claimed, and that therefore all of these claims are in condition for allowance. A formal notice of allowance is requested.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific issue or comment does not signify agreement with or concession of that issue or comment. Because the arguments made may not be exhaustive, there may be reasons for patentability of any or all pending claims (or others) that have not been expressed. Nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Respectfully submitted,

/ Gregory Flickinger /
Gregory Flickinger, Reg No. 45,271
Telephone: 706-291-6071

/ Frederik DeWolf /
Frederik DeWolf

/Steven Lutter/
Steven Lutter